

REMARKS

I. AMENDMENTS TO THE CLAIMS

As may be appreciated from the above listing of claims, claims 1-46 are cancelled herein. New claims 47-66 are presented herein. The Examiner may need to reconsider previously cited art in view of the amendments of the claims made herein.

Support for the amendments of the claims made herein may be found at least at Figures 1-7C and paragraphs 27-68 of the Specification. The paragraph numbers cited herein for the Specification are the paragraph numbers from the published patent application of the present application, US Patent Application Publication No. 2005/0198147 because it was believed citing to the published patent application would make it easier for the Examiner to find the cited portions of the Specification.

II. THE PENDING CLAIMS ARE ALLOWABLE OVER THE CITED ART

The previously presented claims were rejected in view of the combination of U.S. Patent Application Publication Nos. 2003/0021397 to Wengrovitz, 2005/0013421 to Chavez et al. and 2009/0125591 to Kirkpatrick and U.S. Patent No. 6,714,793 to Carey et al. (Office Action, at 2 and 14).

A. Burden Of Proving Obviousness Under 35 U.S.C. § 103

"All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (emphasis added). "When evaluating claims for obviousness under 35 U.S.C. 103, all the limitations of the claims must be considered and given weight." MPEP § 2143.03. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *Id.* "A 35 U.S.C. 103 rejection is based on

35 U.S.C. 102(a), 102(b), 102(e), etc. depending on the type of prior art reference used and its publication or issue date." MPEP § 2141.01.

To establish a *prima facie* case of obviousness, an Examiner must show that an invention would have been obvious to a person of ordinary skill in the art at the time of the invention. MPEP § 2141. "Obviousness is a question of law based on underlying factual inquiries." *Id.* The factual inquiries enunciated by the Court include "ascertaining the differences between the claimed invention and the prior art" and "resolving the level of ordinary skill in the pertinent art." MPEP § 2141.

"A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art' at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP § 2143.01. "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, **there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.**" MPEP § 2143.01 (citing *KSR*, 82 USPQ2d at 1396) (emphasis added).

Moreover, "[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." MPEP § 2143.01. Also, "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." MPEP § 2143.01.

B. Claims 47-51 Are Allowable

Claim 47 is directed to an apparatus that includes a client of a telephonic switch that is a digital display telephone that is able to send and receive instant messaging messages without needing to be off-hook. The telephonic switch has full control of keys of the telephone and receives information for those keys of the telephone. Claims 48-51 depend directly or indirectly from claim 47 and therefore also include these limitations.

None of the cited art teaches or suggests such an apparatus. For instance, Wengrovitz teaches that a messaging server 50 controls the instant messaging that a client of a PBX receives. (Figure 1, ¶¶ 37, 40 and 41). Further, the phones disclosed by Wengrovitz do not instant messages when they are not off-hook. Nor does the PBX disclosed by Wengrovitz have full control of a display for any phones connected to the PBX when the phones are involved in instant messaging.

Moreover, none of the other cited art teaches or suggests such limitations. Therefore claims 47-51 are allowable.

C. Claims 52-66 Are Allowable

Claim 52 is directed to a method of instant messaging. The method includes the steps of communicating instant messaging messages to and from the first client and second client without the digital display telephone set being off hook and the telephonic switch receiving information for the keys pressed at the digital display telephone et and having full control of the display of the digital display telephone set when the digital display telephone set is instant messaging. Claims 53-66 depend directly or indirectly from claim 52 and therefore also contain the limitations of claim 52.

None of the cited art alone or in any combination teach or suggest all the limitations of claims 52-66. As discussed above, none of the cited art teaches or suggests any phone that can instant message when that phone is not off-hook. Nor does the cited art teach or suggest a switch that has full control of a display for any phones connected to the switch. Moreover, none of the cited art teaches or suggests any telephonic switch that has full control over a display of a telephone as required by claims 52-66. Claims 52-66 are allowable over the cited art.

III. CONCLUSION

For at least the above reasons, reconsideration and allowance of all pending claims are respectfully requested.

Respectfully submitted,

Dated: March 7, 2011

/Ralph G. Fischer/

Ralph G. Fischer
Registration No. 55,179
BUCHANAN INGERSOLL & ROONEY PC
One Oxford Centre
301 Grant Street, 20th Floor
Pittsburgh, PA 15219-1410
(412) 392-2121

Attorney for Applicant